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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,810	02/20/2004	Shinsuke Kobayashi	03500.017916	3940
5514	7590	11/22/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			JOERGER, KAITLIN S	
			ART UNIT	PAPER NUMBER
			3653	

DATE MAILED: 11/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/781,810	KOBAYASHI ET AL.
	Examiner Kaitlin S. Joerger	Art Unit 3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1)  Responsive to communication(s) filed on 14 September 2006.
- 2a)  This action is FINAL.                            2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4)  Claim(s) 1,3-11 and 13-20 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1,3-8,10,11,13-18 and 20 is/are rejected.
- 7)  Claim(s) 9 and 19 is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a)  All    b)  Some \* c)  None of:
    1.  Certified copies of the priority documents have been received.
    2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5)  Notice of Informal Patent Application
- 6)  Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-5, 7, 10, 11, 13-15, 17, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Ando et al. (U.S. Patent No. 6,631,252).

Ando et al. teach a sheet transport apparatus comprising:

- a sheet transport path for transporting a sheet, wherein the transport path has a curved transport portion, see figure 8; and
- a regulation member, 7, the regulation member provided on a downstream side of the curved sheet transport path portion in the transport path, being brought into contact with a swelling portion occurring on a surface of an envelope curved by the curved sheet transport path portion to press the swelling portion, see column 1, lines 40+;
- the regulation member faces opposite ends of the envelope in a direction perpendicular to the transport path, see figure 2;
- the apparatus further comprises two pairs of rotary member, 12 and 13, for transporting the sheet, and hold means, 55, for rotatably holding the to be brought into contact with the envelope, the regulation member disposed in the holding means, the regulation members comprises the rotary means;
- the regulation member is spaced a predetermined distance from the envelope.

Ando et al. further teaches an image forming apparatus in which after a toner image formed on an image bearing member is transferred to a sheet, the toner image is fixed, the apparatus comprising:

- a sheet feeding means, 22, for feeding stored sheets one by one;
- a sheet transport path for transporting a sheet, wherein the sheet transport path has a curved sheet transport path disposed between the image bearing member and the sheet feeding means, see figure 8; and
- a regulation member, 7, the regulation member provided on a downstream side of the curved sheet transport path portion, and arranged away from the sheet transported in the transport path, being brought into contact with a swelling portion occurring on a surface of an envelope curved by the curved sheet transport path portion to press the swelling portion, see column 1, lines 40+;
- the regulation member faces opposite ends of the envelope in a direction perpendicular to the transport path, see figure 2;
- the apparatus further comprises two pairs of rotary member, 12 and 13, for transporting the sheet, and hold means, 55, for rotatably holding the to be brought into contact with the envelope, the regulation member disposed in the holding means, the regulation members comprises the rotary means;
- the regulation member is spaced a predetermined distance from the envelope.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 8, 16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ando et al. (U.S. Patent No. 6,631,252).

Ando et al. discloses the invention except for a distance between the regulation member and the envelope that is set to a value in a range between .5 mm and 3.0 mm, he does however disclose changing the distance of the regulation member when an envelope is transported.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to set the distance range between .5mm and 3.0mm as that is a well known range of envelope thicknesses and it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum range involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

#### ***Allowable Subject Matter***

Claims 9 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

Applicant's arguments filed 14 September 2006 have been fully considered but they are not persuasive.

Applicant argues that the claims now define over the prior art because they claim a regulation member, which presses a swelling portion which occurs on an envelope which is transported through a curved portion of a transport path, the applicant argues that the Ando et al. reference does not teach such a feature. The examiner contends that the Ando et al. reference does teach such features. The Ando et al. reference include a curved portion of a transport path, and a regulation member located downstream from the curved portion which press a swelling portion of the envelope. The claims do not states that the swelling of the envelope is cause by transporting the envelope through the curved portion, they merely require a transport path with a curved portion, where an envelop is transported through this curved portion on the way to the regulation member. Ando et al. clearly teaches this feature, as discussed above, and therefore claims 1, 3-8, 10, 11, 13-17, and 20 remain rejected.

Applicant's arguments, see pages 9 and 10, filed 9/14/06, with respect to claims 7, 9, 17, and 19 have been fully considered and are persuasive. The rejections of claims 7 and 9 under 35 U.S.C. 102(b) with respect to Rutishauser and claims 17 and 19 under 35 U.S.C. 103(a) with respect to Rutishauser in view of Ando have been withdrawn.

### *Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kaitlin S. Joerger whose telephone number is 571-272-6938. The examiner can normally be reached on Monday - Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on 571-272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 3653



Kaitlin S. Joerger  
Examiner  
Art Unit 3653

18 November 2006



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